

REMARKS

Upon entry of the foregoing Amendment, claims 1-61 are pending in the application. Claims 34, 56, and 61 are amended and no claims are added or cancelled. In view of these amendments and following remarks, reconsideration and allowance of all the claims pending in the application are respectfully requested.

Drawings

Drawings have been objected to under 37 C.F.R. 1.84 (p)(5) as allegedly failing to include reference 200 in Figures 8(a) and 8(b). Applicants have amended Figures 8(a) and 8(b) to include reference 200. A proposed replacement sheet for Figures 8(a) and 8(b) is filed herewith. Therefore, Applicants respectfully request that this objection be withdrawn.

Claim Objections

Claims 34 and 56 have been objected to as allegedly lacking an article preceding the word "combination." Applicants have amended claims 34 and 56 to overcome this informality. Therefore, Applicants respectfully request that this objection be withdrawn.

Rejection Under 35 U.S.C. § 112

Dependent claims 17-21 and 39-53 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement, and 35 U.S.C. § 112, second paragraph as allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants traverse these rejections for the reasons set forth below.

The Examiner asserts that the specification does not explain how a formula would be resolved continuously (See page 3, lines 3-4 of the Office

Action). The Examiner further asserts that it would have been impossible truly to resolve the formula "continuously" under the plain and ordinary meaning of that word in as much as resolving the formula was inherently discrete act (See page 3, lines 15-17 of the Office Action). However, the specification at page 4, lines 6-10, and page 17, line 17 through page 18, line 6 includes sufficient disclosure to enable one skilled in the art to make and use the invention including the feature of resolving the formula continuously as set forth in the claims. For at least this reason, the rejection of claims 17-21 and 39-53 under 35 U.S.C. § 112, first paragraph is improper and must be withdrawn.

As mentioned above, Applicants' specification sufficiently explains the feature of resolving the formula continuously as set forth in the claims. Therefore, claims 17-21 and 39-53 particularly point out and distinctly claim the subject matter which the applicants regard as the invention. For at least this reason, the rejection of claims 17-21 and 39-53 under 35 U.S.C. § 112, second paragraph is improper and must be withdrawn.

Rejection Under 35 U.S.C. § 102

Claims 1-2, 6-7, 11 and 14 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,987,480 to Donohue et al ("Donohue"). Applicants traverse this rejection because Donohue does not disclose all of the features of the claims.

Claim 1 includes, *inter alia*, the features of "the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document" and "a document insertion module that inserts the insert document into the main document." At least these features are not disclosed, taught or suggested by Donohue.

Apparently, the Examiner relies on the descriptions in Donohue that disclose inserting stored textual contents such as name, user-ID, order-ID, total-due, etc., into a web-based template using dynamic HTML content tags (See col.

6, lines 10-13, col. 7, lines 37-41, and col. 10, lines 60-65 of Donohue). Inserting textual data is not the same as inserting a document that includes the data.

The Examiner asserts that the specification broadly defines "insert document," stating that term "should be understood to include data that may be inserted into a main document," and therefore the data falls within the definition of "insert document" (See page 14, lines 14-16 of the Office Action). This interpretation of insert document by the Examiner is improper because the insert document is not data *per se*. The specification indicates that the insert document includes data (See specification, page 7, lines 4-5). A document that includes data is not the same as data itself.

Accordingly, Donohue does not disclose, teach or suggest inserting the insert document into the main document as set forth in claim 1. For at least this reason, Applicants respectfully submit that claim 1 is patentable over Donohue. Independent claims 6, 11, and 14 recite features similar to those discussed above with regard to claim 1. Therefore, independent claims 6, 11, and 14 are also patentable for at least the reasons set forth above for claim 1.

Dependent claims 2, 7, 22-26, 29, 30, 33-35, 37, 38, 44-48, 51, 52, 55-57, 59, and 60 depend from and add additional features to one of independent claims 1, 6, 11, and 14. Because Donohue does not disclose, teach or suggest each of the features recited in the independent claims, Applicants respectfully submit that dependent claims 2, 7, 22-26, 29, 30, 33-35, 37, 38, 44-48, 51, 52, 55-57, 59, and 60 are also patentable for at least the foregoing reasons.

Rejection Under 35 U.S.C. § 103(a)

Dependent claims 3, 8, 12 and 15 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of U.S. Patent No. 6,226,648 to Appleman et al ("Appleman").

Dependent claims 4, 9 and 13 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of Appleman and further in view of U.S. Patent 6,006,242 to Poole et al ("Poole").

Dependent claims 5, 10, 32, and 54 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of World Wide Web Consortium, *HTML 3.2 Reference Specification*, W3C Recommendation, 14 January 1997, page 107 ("W3C") and further in view of Appleman.

Dependent claim 16 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of Poole.

Dependent claims 17, 36, 39, and 58 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of U.S. Patent 6,442,651 to Crow et al ("Crow").

Dependent claims 27, 28, 31, 49, 50, and 53 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of Using Lotus Notes 4.5 (Que: 1997), page 9, authored by Cate Richards ("Richards").

Each of these dependent claims depend from and add additional features to one of independent claims 1, 6, 11, and 14. As discussed above Donohue does not disclose, teach or suggest each of the features recited in the independent claims and, thus, necessarily fails to teach or suggest each of the features in the dependent claims. None of the references relied upon by the Examiner, alone or in combination with one another, compensates for the deficiencies of Donohue discussed above. Therefore, Applicants respectfully submit that these dependent claims are also patentable at least by virtue of their dependency.

Claim 61

Claim 61 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Donohue in view of Crow. Applicants traverse this rejection

because Donohue and Crow, alone or in combination with one another do not teach all of the features of the claim.

The Examiner apparently has ignored the clauses beginning with the words "in order to" in this claim. Such action is improper. In an effort to advance the prosecution, however, Applicants have amended claim 61 to further clarify that "continuously resolving the formula" and "modifying said identified insert document that is inserted in the main document based on the continuously resolved formula."

Donohue apparently discloses inserting stored textual contents such as name, user-ID, order-ID, total-due, etc., into a web-based template using dynamic HTML content tags. Inserting textual data is not the same as inserting a document that includes the data. Therefore, Donohue does not disclose, teach or suggest inserting the insert document into the main document as set forth in claim 61.

Crow apparently discloses refreshing a web object stored in a cache. However, this not the same as modifying said identified insert document that is inserted in the main document based on the continuously resolved formula, as set forth in claim 61. For at least these foregoing reasons, Applicants respectfully submit that claim 61 is patentable over Donohue in view of Crow.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance and such disposition is earnestly solicited. If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the convenience of the Examiner.

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